

Appl. No. 10/840,122
Examiner: WATSON, ROBERT C, Art Unit 3723
In response to the Office Action dated August 1, 2006

Date: October 20, 2006
Attorney Docket No. 10114111

REMARKS

Responsive to the Office Action mailed on August 1, 2006 in the above-referenced application, Applicant respectfully requests amendment of the above-identified application in the manner identified above and that the patent be granted in view of the arguments presented. No new matter has been added by this amendment.

Present Status of Application

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldberg (US 5,458,312). Claims 9-12 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Claims 13-16 are withdrawn from consideration.

In this paper, claim 1 is amended to recite the limitations of original claims 1, 2 and 12. Claims 2 and 12 are canceled. Claims 3-7 are amended to correspond with amended claim 1. New claims 17-25 are added. Support for the new claims can be found at least in the original claims and Figs. 2a-2c of the application. Thus, on entry of this amendment, claims 1, 3-11 and 13-25 remain in the application.

Reconsideration of this application is respectfully requested in light of the amendments and the remarks contained below.

Allowable Subject Matter

Applicant thanks the Examiner for his indication of allowable subject matter in claims 9-12. In this paper, claim 1 is amended to recite the limitations of allowable claim 12 and intervening claim 2. Applicant therefore submits that claim 1 is now in condition for allowance. Insofar as claims 3-11 depend from claim 1, and therefore include all the limitations of claim 1, they are also believed to be in condition for allowance.

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New Claims 17-25

New claim 17 recites limitations found in original claims 1-2 and 8. In the office action, original claim 8 was rejected under 35 U.S.C. 102(b) as being anticipated by Goldberg. Applicant respectfully traverses the rejections for the reasons discussed below.

The rejections of original claims 1-8 are insufficient, insofar as they do not comply with the requirements of MPEP 707.07 et seq., which requires that all rejections be stated with completeness and clarity.

MPEP 707.07(d) requires that the grounds of a rejection be "fully and clearly stated." The office action fails to meet this requirement in the present application in connection with original claims 1-8.

To anticipate a claim, a reference must teach every element of the claim. In this regard, the Federal Circuit has held:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In the rejection of claims 1-8, the Examiner states:

In Goldberg Figure 4c 46a is a first plate rotatable on a base and 46b is a second plate rotatable on a base and 48 is a fixed device for combining the two plates. Any edge portion of the respective plates may be termed a guide member to guide a screw driver.

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The structure of Goldberg is capable of performing the intended use recited in the claims.

Thus, the rejections identify five elements in Goldberg as the alleged base, first plate rotatable on the base, second plate rotatable on the base, fixed device for combining the two plates, and guide member (which Applicant understands to refer to the first and second guiding portions of claims 3 and 4) of claims 1-8. However, claims 1-8 recite more than a base, first plate, second plate, fixed device, and guide member (guiding portion). As one example, claim 8 recites "a first member disposed on the first plate; and a second member, disposed on the second plate, corresponding to the first member, wherein the first plate is combined with the second plate by the second member combining with the first member." This limitation, which is now found in new claim 17, is not addressed in the office action.

Furthermore, Applicant submits that the identification of a subset of the recited claim elements and a general statement that "the structure of Goldberg is capable of performing the intended use recited in the claims" is insufficient to completely and clearly state the reasons for the rejections of claim 1-8 under 35 U.S.C. 102(b), which requires that ***each and every element as set forth in the claim*** be found, either expressly or inherently described, in a single prior art reference. There is simply no element-by-element analysis set forth in the office action.

Goldberg does not teach or suggest a fixed device combining the first plate and the second plate, and comprising a first member and a second member, wherein the first member is disposed on the first plate, and the second member is disposed on the second plate and corresponds to the first member, as recited in claim 17.

Claim 17 recites a screw mounting jig comprising a base and a supporting assembly. The supporting assembly is disposed on the base, and comprises a first plate, a second plate and a fixed device. The first plate rotates relative to the base, and the second plate rotates relative to the base. The fixed device combines the first plate and the second plate, ***and comprises a first member and a second member. The first member is disposed on the first plate, and the second member is disposed on the second plate and corresponds to the first***

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member. The first plate is combined with the second plate by the second member combining with the first member.

Goldberg discloses an inverted book holder comprising a front member 46a, a back member 46b, and a ratchet 48. The members 46a,b are clamped together by the ratchet 48. As shown in Figs. 4c and 4d, the ratchet 48 is disposed on the back member 46b.

In the office action, the Examiner identifies ratchet 48 as the alleged fixed member of claim 8 (now claim 17). However, contrary to the invention recited in claim 17, the ratchet 48 does not comprise two members disposed on two plates respectively.

For at least the reasons described above, it is Applicant's belief that Goldberg fails to teach or suggest all the limitations of claim 17. Applicant therefore respectfully submits that claim 17 is now in condition for allowance. Insofar as claims 18-25 depend from claim 17 either directly or indirectly, and therefore incorporate all of the limitations of claim 17, it is Applicant's belief that these claims are also in condition for allowance.

Conclusion

The Applicant believes that the application is now in condition for allowance and respectfully requests so.

Respectfully submitted,



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